

REMARKS

I. STATUS OF APPLICATION

Claims 20-31 are canceled and claims 35-46 are added in this paper. Claims 1-19 were previously canceled. Accordingly, claims 32-46 are currently pending in the present Application.

Applicant notes the indication in the Office Action that the requirement for restriction is made final.

II. 35 USC § 112 REJECTIONS

The Office Action indicates that claims 21, 22, 24, 25 and 31 are rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention. Claims 21, 22, 24, 25, and 31 are canceled in this paper. It is respectfully requested that the rejection of claims 21, 22, 24, 25, and 31 be reconsidered and withdrawn, as these claims are no longer pending in the present Application.

III. 35 USC § 102 REJECTIONS

Claims 20-25 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent 2,984,005 to Evich ("Evich"). Claims 20-25 are canceled in this paper. It is respectfully requested that the rejection of claims 20-25 be reconsidered and withdrawn, as these claims are no longer pending in the present Application.

Please note, however, that Applicant addresses the patentability of new claims 35-46 over Evich below.

IV. 35 USC § 103 REJECTIONS

Claims 26 and 29-31 stand rejected under 35 USC § 103(a) as being unpatentable over U.S. Patent 3,203,095 to Nelson ("Nelson") in view of Evich and U.S. Patent 2,990,614 to Taggart ("Taggart"). Claim 27 stand rejected under 35 USC § 103(a) as being unpatentable over Nelson in view of Evich, Taggart, and U.S. Patent 6,487,779 to Underthun ("Underthun"). Claim 28 stands rejected under 35 USC § 103(a) as being unpatentable over Nelson in view of Evich, Taggart, and U.S. Patent 2,348,429 to Walker ("Walker"). Each of the claims rejected under 35 USC § 103(a) in the present Office Action, however, are canceled in this paper. It is respectfully requested that the rejections of these claims be reconsidered and withdrawn, as the claims are no longer pending in the present Application.

Please note that Applicant addresses the patentability of new claims 35-46 over Nelson, Evich, Taggart, Underthun, and Walker below.

V. NEW CLAIMS 35-46 ARE PATENTABLE OVER THE CITED REFERENCES

In the present Office Action, certain claims drawn to a guard for a reciprocating saw are rejected as being anticipated by Evich. New claims 35-38 are drawn to a guard for a reciprocating saw and are allowable over Evich for at least the reasons set forth below.

New independent claim 35 recites a guard for a reciprocating saw comprising a generally planar seal portion. For Evich to anticipate the present invention, as set forth in claim 35, Evich, by definition, must disclose every limitation of the rejected claim in

the same relationship to one another as set forth in claim 35.¹ Evich, however, falls short of this standard. Evich discloses a boot 65 having intermediate portions that are “corrugated or otherwise shaped.”² Thus, Evich fails to disclose the claimed generally planar seal portion and cannot anticipate the present invention, as set forth in claim 35.

Moreover, Evich fails to render the present invention, as set forth in claim 35, obvious. One of ordinary skill in the art at the time of Applicant’s invention would not have been motivated to modify Evich’s “corrugated or otherwise shaped” boot 65 to the claimed generally planar configuration because Evich teaches away from the claimed configuration. It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious.³ The present invention, as set forth in claim 35, therefore, is not rendered obvious by Evich.

Accordingly, independent claim 35 is allowable over Evich. Claims 36-38 depend from independent claim 35 and are allowable over Evich for at least the same reason as set forth above concerning claim 35.

New claim 36 recites a guard for a reciprocating saw comprising a seal portion and an attachment portion extending from the seal portion. The attachment portion exhibits a thickness greater than a thickness of the seal portion. Referring to Figure 5, Evich discloses a boot 65 having a single thickness. Because Evich fails to disclose every limitation of claim 36 in the same relationship to one another as set forth in claim 36, Evich fails to anticipate the present invention, as set forth in claim 36.

¹ *In re Bond*, 15 U.S.P.Q.2d (BNA) 1566, 1567 (Fed. Cir. 1990).

² Evich, col. 4, l. 5; and Figure 5.

³ See, *inter alia*, *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

Moreover, Evich fails to render the present invention, as set forth in claim 36, obvious. The prior art fails to provide any motivation for one of ordinary skill in the art to modify Evich's constant-thickness boot 65 to have an attachment portion exhibiting a thickness greater than a thickness of a seal portion thereof. "The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."⁴ Accordingly, absent any motivation to modify Evich, Evich cannot render the present invention, as set forth in claim 36, obvious.

In the present Office Action, certain claims drawn to a reciprocating saw are rejected as being obvious over various combinations of Nelson, Evich, Taggart, Underthun, and Walker. New claims 39-46 are drawn to a reciprocating saw and are allowable over Nelson, Evich, Taggart, Underthun, and Walker, whether taken singly or in combination, for at least the reasons set forth below.

Independent claim 39 recites a reciprocating saw comprising a guard member having a generally planar seal portion. Nelson, Underthun, and Walker are silent with regard to any guard member. Evich fails to disclose or suggest a generally planar seal portion as discussed above concerning claim 35. While Taggart discloses a guard 40, Taggart is silent with regard to any seal portion thereof and, in particular, to any generally planar seal portion. The Court of Appeals for the Federal Circuit has made it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention.⁵ Because Nelson, Evich, Taggart, Underthun, and

⁴ *In re Gordon*, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984); *In re Brouwer*, 37 U.S.P.Q.2d (BNA) 1663, 1666 (Fed. Cir. 1995); *In re Ochiai*, 37 U.S.P.Q.2d (BNA) 1127, 1131 (Fed. Cir. 1995).

⁵ *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002).

Walker, whether taken singly or in combination, fail to achieve this standard, the present invention, as set forth in claim 39, is allowable over Nelson, Evich, Taggart, Underthun, and Walker.

Moreover, Taggart and Walker are not analogous to the present invention. "Two criteria have evolved for determining whether prior art is analogous: (1) [W]hether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved."⁶ Taggart relates to the field of cutting baled cotton and Walker relates to the field of cutting armor, sheathing, insulation, and the like from electric conductor cables. The present invention, however, is related to reciprocating saws useful in cutting materials that are moist or have liquid components. Thus, neither Taggart nor Walker is from the same field of endeavor as the present invention.

The particular problem with which Applicant is involved is inhibiting the introduction of debris, such as particles of flesh, hair, bone, and the like, from entering the saw's housing. Taggart is directed to solving the problem of converting a power tool to a power operated cutter for cutting baled cotton. Walker is directed to solving the problem that prior knives were not well suited to cutting armor, sheathing, insulation, and the like from electric conductor cables. Accordingly, neither Taggart nor Walker is reasonably pertinent to the particular problem with which Applicant is involved. Neither Taggart nor Walker, therefore, is properly combinable with each other or any other reference to render the present invention obvious.

For at least these reasons, independent claim 39 is allowable over Nelson, Evich, Taggart, Underthun, and Walker, whether taken singly or in combination. Claims 40-46 depend from claim 39 and are allowable over Nelson, Evich, Taggart, Underthun, and Walker for at least the same reasons set forth above concerning claim 39.

New claim 40 recites a reciprocating saw comprising a guard member having a seal portion and an attachment portion extending from the seal portion. The attachment portion exhibits a thickness greater than a thickness of the seal portion. Nelson, Underthun, and Walker are silent with regard to any guard member. Evich fails to disclose or suggest an attachment portion exhibiting a thickness greater than a thickness of a seal portion, as required by claim 40. While Taggart discloses a guard 40, Taggart is silent with regard to any attachment portion exhibiting a thickness greater than a thickness of a seal portion, as required by claim 40. Moreover, as discussed above, Taggart and Walker are not analogous to the claimed invention. Accordingly, claim 36 is allowable over Nelson, Evich, Taggart, Underthun, and Walker, whether taken singly or in combination.

New claim 41 requires the saw blade of the reciprocating saw be configured for field-dressing an animal carcass. The Nelson power-operated knife is for use in "accomplishing conventional food cutting chores," such as slicing "softer food items, such as bread, warm meats and particular vegetables, such as tomatoes."⁷ Nelson, however, is silent with regard to the suitability of its power-operated knife in field-dressing an animal carcass. Evich's power-driven knife is useful in cleaning and dressing meat, fish, and the like in fish canneries and meat packing establishments. In

⁶ *In re Clay*, 966 F.2d 656, 658-59 (Fed. Cir. 1992) (reversing Board holding of obviousness).

such uses, meat is cut away from bone, as evidenced by Evich disclosing a knife. In field-dressing, both meat and bone are cut and Evich's knife is not suitable or capable of cutting bone. Underthun discloses a fillet knife, which one of ordinary skill in the art would appreciate would not be capable of cutting bone. As noted above, neither Taggart nor Walker is related to any aspect of cutting meat. Accordingly, neither Nelson, Evich, Taggart, Underthun, or Walker, whether taken singly or in combination, teaches or suggests saw blade configured for field-dressing an animal carcass, as required by claim 41.

New claim 42 requires the saw blade to be configured to cut bone. The present invention, as set forth in claim 42, is allowable over Nelson, Evich, Taggart, Underthun, and Walker for at least the same reasons set forth above concerning claim 41.

Accordingly, in light of the foregoing remarks, new claims 35-46 are allowable over Nelson, Evich, Taggart, Underthun, and Walker.

⁷ Nelson, col. 1, ll. 10, 26, and 27.

CONCLUSION

Wherefore, in view of the foregoing remarks, this application is considered to be in condition for allowance, and an early reconsideration and issuance of a Notice of Allowance are earnestly solicited. The Examiner is invited to contact the undersigned at (817) 578-8616 with any questions, comments, or suggestions relating to the referenced patent application.

Respectfully submitted,

21 FEB 2006

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